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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,166	04/29/2002	Jochen Wurtz	514413-3896	4932

20999 7590 06/26/2003

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EXAMINER

CLARDY, S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 06/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/937,166

Applicant(s)

Wurtz et al

Examiner

S. Mark Clardy

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Apr 1, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4, 6 6) ☐ Other:

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Claims 1-13 are pending in this application which has been filed under 35 USC 371 as a national stage application of PCT/EP00/02207, filed March 13, 2001. This application possesses unity of invention under 37 CFR 1.475 (MPEP 1850, 1893.03(d)).

Applicants' claims are drawn to:

- A) a surfactant/solvent system (claims 1-5) and the use thereof (claims 12-13), comprising:
- 1) "aromatic-based" surfactant(s)<sup>1</sup>
  - 2) esterified organic phosphates and/or phosphonate solvent(s) (claim 4):
    - b2.1 "largely water-insoluble" polar esters of phosphoric acid<sup>2</sup>
    - b2.2 "largely water-insoluble" polar phosphonates<sup>3</sup>
- B) an active agent formulation and methods of making and using it (claims 6-11), comprising:
- a) water insoluble active agent(s) such as pesticides (claim 7)  
(claim 9: herbicides desmedipham, phenmedipham, ethofumesate)
  - b) the above surfactant/solvent system
  - c) optional: organic solvents
  - d) optional: surfactants and/or polymers
  - e) optional: water.

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<sup>1</sup>Claim 2: phenols, phenyl C<sub>1-4</sub> alkyl ethers, (poly)alkoxylated phenols; (poly)alkylphenols or (poly)alkylphenol alkoxylates; polyarylphenols or polyarylphenol alkoxylates; reaction products of b1.1 + b1.3 + sulfuric or phosphoric acid, salts; neutralized acidic (poly)alkyl- and (poly)arylbenzenesulfonates

<sup>2</sup>Esterified with C<sub>5-22</sub> alkanols, diols or polyols, aryl, alkaryl, poly(alkyl)aryl or poly(arylalkyl)aryl alcohols, alkoxylated forms of the preceding alcohols, alkoxylated C<sub>1-4</sub> alkanols

<sup>3</sup>Alkyl- aryl-, alkylaryl-, poly(alkyl)aryl-, poly(arylalkyl)arylphosphonic acid diesters with C<sub>1-22</sub> alkanols, diols or polyols, aryl, alkaryl, poly(alkyl)aryl or poly(arylalkyl)aryl alcohols, alkoxylated (preferably C<sub>1-4</sub>O) forms of the preceding alcohols

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35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 12 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, i.e., "use" of a compound which is a non-statutory class of invention in US practice. Recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, and a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Heinrich (PCT WO 91/06215) and Bertrand (FR 2 599 593).

Heinrich teaches herbicidal compositions comprising, among other components, phosphoric acid esters of aliphatic mono-, di-, or polyalcohols (p. 5, lines 1-15), organic solvents, particularly aromatic solvents (lines 32-35), and additional components such as alkylphenolpolyglycol ether (i.e., polyalkoxylated alkylphenols, p. 6, line 6).

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Bertrand teach herbicides including phenmedipham and desmedipham (p. 1, lines 15-21), in combination with tributyl phosphate (p. 2, line 35) and polyalkoxyphenol phosphate ester surfactants (p. 4), and alkylphenols, polyalkylphenols, or polyalkoxylated (poly)alkylphenols (p. 3).

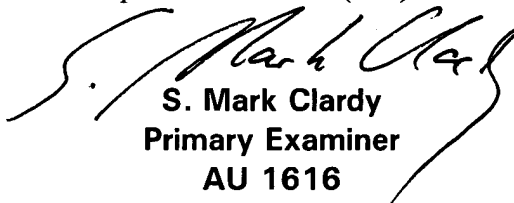
One of ordinary skill in the art would be motivated to combine these references because they disclose the utility of polyalkoxylated surfactants in herbicidal compositions

Thus it would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to have combined applicants' surfactants and solvents in a single composition for use in herbicidal formulations because the prior art teaches that these components are known in the art of herbicide formulation. Further, it is conventional in the art to combine surfactants and solvents with herbicides in order to enhance their uptake into target plants.

No unobvious or unexpected results are noted; no claim is allowed.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103c and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Mark Clardy whose telephone number is (703) 308-4550.

  
S. Mark Clardy  
Primary Examiner  
AU 1616

June 25, 2003